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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 10/520,676   | 01/11/2005  | Woo-cheul Jung       | 29137.012.00-US         | 9379             |
| 30827  | 7590        | 09/07/2006           |                         |                  |
| MCKENNA LONG & ALDRIDGE LLP<br>1900 K STREET, NW<br>WASHINGTON, DC 20006 |             |                      | EXAMINER<br>LE, HOA VAN |                  |
|  |             |                      | ART UNIT<br>1752        | PAPER NUMBER     |
| DATE MAILED: 09/07/2006  |             |                      |                         |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/520,676

**Applicant(s)**

JUNG ET AL.

**Examiner**

Hoa V. Le

**Art Unit**

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11 January 2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

This application is before the examiner for consideration on the merits.

I. Applicants' prior art submission filed on 11 January 2005 has been considered to the extent of the English language being provided.

II. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamaguchi et al (5,536,612).

Yamaguchi et al disclose and teach a toner having a single and/or double layer structure (Should applicants show or urge that each of the (1) single layer structure and (2) double layer structure toners are patentably different or distinct in the next response to this Office action in order for it to be considered timely, a restriction will be made for the record as shown or urged on the record). For now, they are considered and searched as no patentably different or distinct combination-subcombination. Accordingly, no separate consideration or search has been made. A distinction as disagreed, admitted, shown and/or urged for the record is sufficient for a restriction to be made following the next response to this Office action. It is now clearly pointed out and set forth for the record). The claims are product-by-process. Accordingly, an allowed claim or patent would have no value when someone shows that a product-by-process as claimed has, give or provide the same or about the same or obviously less result than that of a known toner in the art because the product-by-process as claimed dose not has, give or provide an improvement or unusual or unexpected result to

contribute to the electric or magnetic imagery for a patentability as claimed.

The showings in the instant specification have been considered but have little value as compared to the broadly claimed embodiments with respect to each and all specific chemical ingredients and their effective amounts as tested. The language “binder resin monomers, molecular weight controlling agents, pigments, charge controlling agents, dispersion agents, anionic surfactants, waxes, polar grafting agents, hydrophilic monomers” or “polymers”, “styrene-group monomer” and “cross-linking agent” or the like is a property of a material. They are broadly to read on others. The single layer structure comprises the chemical ingredients being read on binder resin monomers, molecular weight controlling agents, pigments, charge controlling agents, dispersion agents, anionic surfactants, waxes, polar grafting agents, hydrophilic monomers. The second layer structure comprises chemical ingredients being read on a styrene-group monomer and cross-linking agent. The toner is produced by a suspension polymerization process. Please see the whole disclosure or the applied reference, especially at col.5:1-11:20 and 51 to 14:11 and Examples. As the level of one skill in the art, the functional properties of the materials are inherent. For a patentability of a functional material, it is allowed by law to require and

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request applicants to show a convincing evidence to the contrary since arguments alone are not a factual evidence. In accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows that the property materials are in the applied references as broadly disclosed and claimed. Since Yamaguchi et al are reasonably disclosed and teach the toner, the above claims are found to be anticipated by Yamaguchi et al.

In an alternative, the chemical ingredients are not in an example are reasonably found to be rendered prima-facie obvious by Yamaguchi et al.

III. Claims 4 and 6-15 are rejected under 35 U.S.C. 103(a) as obvious over Yamaguchi et al (5,536,612).

Yamaguchi et al disclose and teach a toner having a single and/or double layer structure (Should applicants show or urge that each of the (1) single layer structure and (2) double layer structure toners are patentably different or distinct in the next response to this Office action in order for it to be considered timely, a restriction will be made for the record as shown or urged on the record). For now, they are considered and searched as no patentably different or distinct combination-subcombination. Accordingly,

no separate consideration or search has been made. A distinction as disagreed, admitted, shown and/or urged for the record is sufficient for a restriction to be made following the next response to this Office action. It is now clearly pointed out and set forth for the record). The claims are product-by-process. Accordingly, an allowed claim or patent would have no value when someone shows that a product-by-process as claimed has, give or provide the same or about the same or obviously less result than that of a known toner in the art because the product-by-process as claimed dose not has, give or provide an improvement or unusual or unexpected result to contribute to the electric or magnetic imagery for a patentability as claimed. The showings in the instant specification have been considered but have little value as compared to the broadly claimed embodiments with respect to each and all specific chemical ingredients and their effective amounts as tested. The language “binder resin monomers, molecular weight controlling agents, pigments, charge controlling agents, dispersion agents, anionic surfactants, waxes, polar grafting agents, hydrophilic monomers” or “polymers”, “styrene-group monomer” and “cross-linking agent” or the like is a property of a material. They are broadly to read on others. The single layer structure comprises the chemical ingredients being read on binder resin

monomers, molecular weight controlling agents, pigments, charge controlling agents, dispersion agents, anionic surfactants, waxes, polar grafting agents, hydrophilic monomers. The second layer structure comprises chemical ingredients being read on a styrene-group monomer and cross-linking agent. The toner is produced by a suspension polymerization process. Please see the whole disclosure or the applied reference, especially at col.5:1-11:20 and 51 to 14:11 and Examples. As the level of one skill in the art, the functional properties of the materials are inherent. For a patentability of a functional material, it is allowed by law to require and request applicants to show a convincing evidence to the contrary since arguments alone are not a factual evidence. In accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows that the property materials are in the applied references as broadly disclosed and claimed.

Yamaguchi et al disclose, teach and suggest a send layer for the benefit of obtaining a storage stability but do not further specify a third layer. However, it is obvious to one having ordinary skill in the art at the time the invention was to add an additional third layer for an additive storage stability. However, an allowed claim or patent would have no value when



someone shows that an addition of a third a layer dose not have, give or provide an additional storage stability with some them such as the thicknesses of both second layer and third layer in the instant claims is the same or less than the thickness of a second layer in the applied reference and the thickness of the third layer in the instant claims is much thicker than that in the applied reference. In this case, the storage many be obtained. But the image quality may not as good as in that in the applied reference. The instant claims are broadly read on some of these situations.

There could be a patentable criticality of claim 4 or any other claim when applicants show or provide an unusual or unexpected result over those in the applied references provided that a claim must be reasonably commensurate with a showing with respect to each and all specific chemical ingredients, their amounts, thickness of the instant claimed second and third layers as compared to the thickness of Yamaguchi et al second layer thickness. An allowed claim or patent would have no value when someone shows that the broad embodiments has, give or provide no unusual or unexpected result over that in the applied reference as now on the record.

For the reasons as clearly pointed out and set forth on the record, the claims are reasonably found to be rendered prima-facie obvious by

Yamaguchi et al in the absence of an unusual or unexpected result over those in the applied references.

IV. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
05 September 2006

HOA VAN LE  
PRIMARY EXAMINER  
